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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/020,094

12/13/2001

Thomas E. Coverstone

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Schubert Law Group PLLC

6013 CANNON MOUNTAIN DRIVE, S14

AUSTIN, TX 78749

EXAMINER

D AGOSTA, STEPHEN M

ART UNIT

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2617

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/020,094	<b>Applicant(s)</b> COVERSTONE, THOMAS E.	
	<b>Examiner</b> Stephen M. D'Agosta	<b>Art Unit</b> 2617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 20 April 2010.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 76-80 and 88-92 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 76-80 and 88-92 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 4-20-10 has been entered.

1. The RCE contains no claim amendments hence the examiner puts forth a FINAL ON FIRST rejection.
2. The examiner continues to give the broadest, most reasonable interpretations to the claims and believes the prior art of record fully rejects the claims. The examiner invites the applicant to amend the claims such that they separate themselves from the prior art and more narrowly define the inventive concept.

3. Summarizing the examiner's (previous) response to arguments:

- i. . The applicant argued that Hidary didn't teach using location being used/determined. The examiner disagreed since Hidary does explicitly teach identifying the user's location such that a pertinent advertisement can be sent:

The ad server 24 first determines the identity of the subscriber using subscriber identifier 52 (step 106). The ad server 24 further determines the location of the subscriber (in this case, cell 11) using subscriber locator 54. The identifiers 52 and 54 are shown as part of the ad server 24 for the sake of convenience, it being understood that these elements may be part of the master station as well. Moreover, while these elements are shown as discrete elements for the sake of clarity, preferably they are implemented as software. The microprocessor 50 uses this information to look up in data bank 26 the profile of subscriber 16 (step 110). From the profile the ad server then has to select an appropriate message from the messages stored in memory bank 26. (C3, L4-17)

Clearly Hidary is teaching that "an appropriate message" is based on the user's profile and location.

Another embodiment has the user asking for information regarding a proximate location/place/need:

In yet another embodiment of the invention, subscriber 16 may be actively seeking information from the information bank 26. For example, subscriber 16 may not be familiar with cell 11 and may require information regarding a convenient restaurant, gas station, etc. For this purpose, subscriber 16 sends a code to central station 12 to indicate that he wants to access the memory bank 26. The ad server 24 again identifies the subscriber 16 and his cell 11 provides the subscriber with a list of messages that are available from the memory 60. The subscriber then selects one of these options and receives the corresponding message or messages. (C4, L26-37)

ii. The examiner noted that the applicant's IDS provides known prior art whereby a user's location is positively identified in reference to a specific location, object or person. Note that while a specific "location" is optimal, the ability to determine if a user is near another object or person still reads on the claim since the overall function is determining how a user's location relates to another location/object/person (eg. is user 1 nearby to "something", which triggers something else to happen, send a message, send an alert, download data, etc).

a. Hoshen teaches determining if/when two people come in proximity to each other and sending the one person an alert.

b. Clark teaches sending location-based messages when a user roams into a certain area.

iii. The examiner reminded the applicant that the **recent landmark KSR ruling** put forth that simple substitution of one known element/application for another to a piece of prior art ready for improvement is not patentable under 35 USC 103(a).

Furthermore rationales include Predictable Results, Known Techniques, Obvious to Try and Motivation(s) from others/other art.

Accordingly, the claims are viewed as a combination that only unites elements with no change in respective functions of those elements and said combination yields predictable results.

Absent evidence that the modifications necessary to effect the combination of elements is uniquely challenging or difficult for one of ordinary skill the claims are also deemed unpatentable.

iv. Lastly, the examiner noted that considerable prior art had been put forth in the office actions (pertinent but not cited) that recite similar concepts as Hidary, Hoshen and Clark. Even Owensby teaches determining the location of the user and sending appropriate messages (see claims 77 and 89).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 76, 78, 88 and 90** rejected under 35 U.S.C. 103(a) as being unpatentable over Hidary and further in view of Hoshen and Clark.

As per **claims 76 and 88**, Hidary teaches a wireless communication system for use with a wireless communication device and a position location system providing position location data indicating positions of the wireless communication device as the wireless communication device moves (Abstract teaches a wireless network/user and determining location of the user C3, L4-17), said wireless communication system comprising:

a memory containing a database of user selections (figure 1 shows a MEMORY BANK #22 and another MEMORY BANK with User Profile which can contain user preferences/selections, see C3, L18-24) and ,

a processor for receiving the position location data from the position location system and for processing the position location data and the database of user selections contains a selection of the user of the wireless communication device indicating that the user of the wireless communication device has an interest in receiving an advertisement (C3, L 4-29 teaches determining user location and then reading the user's preferences based on user-provided information and then sending selected advertisement), and

a transmitter for transmitting the advertisement of the business at the certain location to the wireless communication device the database of user selections contains a selection of the user of the wireless communication device indicating that the user of the wireless communication device has an interest in receiving an advertisement (C3, L4-50 which teaches, for example, that the user has a 4 year old car and may want an advertisement from a local car dealer);

**But is silent on** determining location in relation/proximity to another location/object/person and sending an appropriate response/message/alert.

a. Hoshen teaches determining if/when two people come in proximity to each other and sending the one person an alert (Abstract, figure 1, C1, L50 to C2, L57).

b. Clark teaches sending location-based messages when a user roams into a certain area (Abstract, figures 4-7 and C2, L40-55).

It would have been obvious to one skilled in the art at the time of the invention to modify Hidary, such that the system determines a user's location and sends appropriate messages in relation to that location/proximity, to provide targeted messages to the user as based on that specific location (eg. alerts, sales, activities, danger, traffic congestion, etc).

As per **claims 78 and 90**, Hidary teaches claim 76, wherein the wireless communication device is a cell phone (Hidary teaches a cellular network and cell phone users, see figure 1, #16a).

**Claims 77 and 89** rejected under 35 U.S.C. 103(a) as being unpatentable over Hidary and further in view of Owensby.

As per **claims 77 and 89**, Hidary claim 76, **but is silent on** wherein the position location system is the Global Positioning Satellite (GPS) system.

Owensby teaches providing targeted messages to a mobile (eg. advertisements, etc) and location determination which can use triangulation, GPS, etc. (see Abstract, C15, L50-60 for advertisements and C12, L30-40 for GPS).

It would have been obvious to one skilled in the art at the time of the invention to modify Hidary, such that GPS is used, to provide a more accurate location determination technology which is better than using either CELL-ID or Triangulation to fully understand the exact location of a user for targeted marketing.

**Claims 79-80 and 91-92** rejected under 35 U.S.C. 103(a) as being unpatentable over Hidary/Owensby and further in view of Taylor.

As per **claims 79 and 91**, Hidary teaches claim 76, wherein the memory further contains a information (eg. data or database) of user purchases, and wherein the processor is coupled to the memory for accessing the database of user purchases to determine whether or not purchases made by the user of the wireless communication device indicates that transmission of the advertisement of the business at the certain location to the wireless communication device may be of interest to the user of the wireless communication device, and the processor is coupled to the transmitter for enabling the transmitter to transmit the advertisement at the certain location to the

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wireless communication device only when purchases made by the user of the wireless communication device indicates that transmission of the advertisement at the certain location to the wireless communication device may be of interest to the user of the wireless communication device (C3, L39-50: The messages stored in memory bank 26 and delivered to the subscriber may be any one of a plurality of messages dependent on the subscriber's profile and location of cell 11. For example, if the subscriber has indicated that he likes to go to the movies, the message delivered during step 114 from memory 60 may be a brief advertisement for a recently released movie and where that movie is playing in, or close to cell 11. If the subscriber indicates that he is an avid sports fan, the message from memory 64 may indicate when the subscriber's favorite team plays in his area. **If his profile indicates that he has a four year old car, the message may be an advertisement from a local car dealer for a new car)** but is silent on including a history of purchases made by the user of the wireless communication device.

Hidary's user profile can be viewed as storing answers about user purchases which would be broadly interpreted as "a history of purchases" (eg. the example discloses asking the user how old their car is). The examiner notes that smaller-ticket purchases could be determined as well (eg. a question about how much or how often does a user shop for food, clothing, household items, etc) which would better parallel a "history" (instead of just a big-ticket purchase like a car).

At least **Owensby** teaches using "historical" data for targeting advertising data at/to a user (Abstract teaches storing/tracking historical answers or movements of a user, eg. where "answers" would be "how often do you shop for food?" and can infer a history, also see C1, L25-35: In another alternative embodiment, the commercial information or advertisements are further targeted to the subscriber on the basis of **Historical Response Data relating to the responses made to the targeted messages previously**



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provided to the subscriber, note that “targeted messages” can be question(s) relating to if the user just purchased a good/service).

Furthermore, **Taylor** teaches tracking/storing a user's purchase history: It would be very desirable to substitute a system that automatically kept track of purchases and awarded discounts or coupon equivalents automatically depending upon current purchases and/or history of purchases, broken down by brand and in other ways. (C2, L1-10)

It would have been obvious to one skilled in the art at the time of the invention to modify Hidary, such that a history of purchases is tracked/stored, to provide means for the advertisers to know what a user has purchased before in order to target their marketing material based on user purchases trend data.

As per **claims 80 and 92**, Hidary teaches claim 76, wherein the memory further contains a history of positions of the wireless communication device, and wherein the processor is coupled to the memory for accessing the location of the wireless communication device to determine whether or not the position of the wireless communication device indicates that transmission of the advertisement at the certain location to the wireless communication device may be of interest to the user of the wireless communication device, and the processor is coupled to the transmitter for enabling the transmitter to transmit the advertisement of the business at the certain location to the wireless communication device only when the position of the wireless communication device indicates that transmission of the advertisement the certain location to the wireless communication device may be of interest to the user of the wireless communication device (Hidary teaches determining a user's position for targeting advertisements, see above) **but is silent on** a history of positions.

Owensby clearly teaches that a user's location history can tracked/stored (In yet another alternative embodiment, the commercial information or advertisements are further targeted to the subscriber on the

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basis of Historical Response Data relating to the historical movement patterns of the subscriber, C1, L25-35)

Furthermore, Taylor teaches tracking/storing a user's purchase history: It would be very desirable to substitute a system that automatically kept track of purchases and awarded discounts or coupon equivalents automatically depending upon current purchases and/or history of purchases, broken down by brand and in other ways. (C2, L1-10)

It would have been obvious to one skilled in the art at the time of the invention to modify Hiday, such that a history of positions is tracked/stored, to provide means for the advertisers to know where a user has been before and where they are roaming to in order to target their marketing material.

### **Conclusion**

All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen M. D'Agosta whose telephone number is 571-272-7862. The examiner can normally be reached on M-F, 8am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lewis West can be reached on 571-272-7859. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Stephen M. D'Agosta/  
Primary Examiner, Art Unit 2617